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EXAMINER

VIG, NARESH

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7
8 *Ex parte* NEREIDA MARIA MENENDEZ, PAULA S. WILLIAMS, and
9 MICHAEL J. MANIS
10

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12 Appeal 2007-3067
13 Application 09/698,502
14 Technology Center 3600
15

16
17 Decided: February 20, 2008
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20 Before WILLIAM F. PATE, III, ANTON W. FETTING, and JOSEPH A.
21 FISCHETTI, *Administrative Patent Judges*.
22 FETTING, *Administrative Patent Judge*.
23

24 DECISION ON APPEAL
25

26 STATEMENT OF CASE

27 Nereida Maria Menendez, Paula S. Williams, and Michael J. Manis
28 (Appellants) seek review under 35 U.S.C. § 134 of a final rejection of claims
29 1-18, the only claims pending in the application on appeal.

1 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
2 (2002).

3
4 We AFFIRM.

5 The Appellants invented a way for completing and storing an
6 electronic rental agreement for an item or service, such as a vehicle rental
7 service (Specification 1:15-17).

8 An understanding of the invention can be derived from a reading of
9 exemplary claim 1, which is reproduced below (bracketed matter and some
10 paragraphing added).

11 1. A method for completing and storing an electronic rental
12 agreement, said method comprising the steps of:

13 [1] entering

14 reservation-related information and

15 rental-related information

16 for an item or service,

17 said entering step entering:

18 (a) said rental-related information without employing a
19 master rental agreement, or

20 (b) at least some of said rental-related information from a
21 master rental agreement and allowing modification of
22 said information from the master rental agreement for
23 rental of said item or service without modifying the
24 master rental agreement;

25 [2] providing a reservation for said item or service based at
26 least in part upon said reservation-related information;

27 [3] creating and displaying a rental proposal based upon said
28 reservation and said rental-related information;

29 [4] electronically accepting said rental proposal; and

1 [5] storing the electronic rental agreement based upon said
2 accepted rental proposal.

3

4 This appeal arises from the Examiner's Final Rejection, mailed May
5 11, 2004. The Appellants filed an Appeal Brief in support of the appeal on
6 February 7, 2005. An Examiner's Answer to the Appeal Brief was mailed
7 on March 7, 2007. A Reply Brief was filed on November 9, 2005.

8

PRIOR ART

9 The Examiner relies upon the following prior art:

Coutts US 5,389,773 Feb. 14, 1995

10 Information on Hertz Corporation, archived web pages printed through
11 www.archive.org (1997-2000),

12 Avis Rent A Car – Rates and Reservations,
13 http://www.avis.com/rates_and_reservations/ (last visited March 03, 2000).

14 Dollar Rent A Car Introduces “DOLLAR(R) TRAVEL CENTER” at Key
15 Airport Locations, Customers Obtain Free Travel Information At Interactive
16 Kiosks, http://www.kioskcom.com/articles_txtdetail.php?ident=115 (last
17 visited May 14, 2000)(hereinafter Kioskcom).

18

REJECTIONS

19 Claims 1-5, 10-12, 14-16, and 18 stand rejected under 35 U.S.C. §
20 103(a) as unpatentable over Hertz and Avis.

21 Claims 6-9 stand rejected under 35 U.S.C. § 103(a) as unpatentable
22 over Hertz, Avis, and Coutts.

23 Claims 13 and 17 stand rejected under 35 U.S.C. § 103(a) as
24 unpatentable over Hertz, Avis, and Kioskcom.

ISSUES

The issues pertinent to this appeal are

- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1-5, 10-12, 14-16, and 18 under 35 U.S.C. § 103(a) as unpatentable over Hertz and Avis.
- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 6-9 under 35 U.S.C. § 103(a) as unpatentable over Hertz, Avis, and Coutts.
- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 13 and 17 under 35 U.S.C. § 103(a) as unpatentable over Hertz, Avis, and Kioskcom.

The pertinent issues turn on whether the art describes a rental agreement.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are supported by a preponderance of the evidence.

Claim Construction

01. The disclosure contains no lexicographic definition of “agreement.”

02. The ordinary and customary meaning of “agreement” is (1) the act of agreeing; (2) harmony of opinion; accord; (3) an arrangement between parties regarding a course of action; a covenant; (4) Law (a) a properly executed and legally binding

contract; or (b) the writing or document embodying this contract.¹

These definitions are substantially the same as those provided by the Appellants in the Evidence Appendix to the Appeal Brief.

03. The disclosure contains no lexicographic definition of a master agreement.

04. The usual and customary meaning of “master” as an adjective is (1) to act as or be the master; (2) principal or predominant; (3) controlling all other parts of a mechanism; (4) highly skilled or proficient; or (5) being an original from which copies are made.¹

Admissions

05. The Appellants admit that Hertz describes accepting a reservation proposal and storing an electronic reservation agreement (Appeal Br. 5:Second ¶).

Hertz

06. Hertz is a web site for Hertz, the car rental company, which provides the contents of the legal requirements for its agreements and provides screens for customers to enter rental reservations.

07. Hertz describes its system as allowing a customer to make, modify, or cancel a reservation (Hertz 27).

08. Hertz describes the use of a customer profile for entering data into a reservation (Hertz 17).

¹ *American Heritage Dictionary of the English Language* (4th ed. 2000).

1 09. Hertz portrays radio button selection of entry by customers with
2 existing profiles and general customers (Hertz 36).

3 10. Hertz describes an offer for a rental vehicle for value containing
4 the material terms of the agreement, and requesting acceptance by
5 the customer (Hertz 44).

6 *Avis*

7 11. Avis describes entry and storage of a vehicle rental reservation.

8 *Kioskcom*

9 12. Kioskcom describes using kiosks by Dollar Rent-A-Car.

10 *Coutts*

11 13. Coutts is directed to a self-service system arranged to store data
12 relating to previous transactions initiated by various users of the
13 system, and arranged to predict the type of transaction to be
14 initiated by a given user, the mode of operation of said system
15 when performing a transaction for a particular user being
16 dependent on a prediction made by said prediction means
17 following identification of that user (Coutts 1:36-51).

18 14. Coutts describes its contents as applicable to self service
19 systems, of which ATM's are examples (Coutts 1: 7-20).

20 *Knowledge in the art*

21 15. One of ordinary skill knew that a Boolean data element to
22 signify the presence or absence of an item was known as a *flag*.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily).

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the Specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

1 *Obviousness*

2 A claimed invention is unpatentable if the differences between it and
3 the prior art are “such that the subject matter as a whole would have been
4 obvious at the time the invention was made to a person having ordinary skill
5 in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int’l v. Teleflex Inc.*, 127 S.Ct.
6 1727, 1729-30 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14
7 (1966).

8 In *Graham*, the Court held that that the obviousness analysis is
9 bottomed on several basic factual inquiries: “[(1)] the scope and content of
10 the prior art are to be determined; [(2)] differences between the prior art and
11 the claims at issue are to be ascertained; and [(3)] the level of ordinary skill
12 in the pertinent art resolved.” 383 U.S. at 17. *See also KSR Int’l v. Teleflex*
13 *Inc.*, 127 S.Ct. at 1734. “The combination of familiar elements according to
14 known methods is likely to be obvious when it does no more than yield
15 predictable results.” *KSR*, at 1739.

16 “When a work is available in one field of endeavor, design incentives
17 and other market forces can prompt variations of it, either in the same field
18 or in a different one. If a person of ordinary skill in the art can implement a
19 predictable variation, § 103 likely bars its patentability.” *Id.* at 1740.

20 “For the same reason, if a technique has been used to improve one
21 device, and a person of ordinary skill in the art would recognize that it would
22 improve similar devices in the same way, using the technique is obvious
23 unless its actual application is beyond his or her skill.” *Id.*

1 “Under the correct analysis, any need or problem known in the field
2 of endeavor at the time of invention and addressed by the patent can provide
3 a reason for combining the elements in the manner claimed.” *Id.* at 1742.

4 *Automation of a Known Process*

5 It is generally obvious to automate a known manual procedure or
6 mechanical device. Our reviewing court stated in *Leapfrog Enterprises Inc.*
7 *v. Fisher-Price Inc.*, 485 F.3d 1157 (Fed. Cir. 2007) that one of ordinary
8 skill in the art would have found it obvious to combine an old
9 electromechanical device with electronic circuitry

10 to update it using modern electronic components in order to
11 gain the commonly understood benefits of such adaptation, such as
12 decreased size, increased reliability, simplified operation, and reduced
13 cost. . . . The combination is thus the adaptation of an old idea or
14 invention . . . using newer technology that is commonly available and
15 understood in the art.

16 *Id* at 1163.

17 *Obviousness and Nonfunctional Descriptive Material*

18 Nonfunctional descriptive material cannot render nonobvious an
19 invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d
20 1336, 1339 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385 (Fed.
21 Cir. 1983) (when descriptive material is not functionally related to the
22 substrate, the descriptive material will not distinguish the invention from the
23 prior art in terms of patentability).

24 ANALYSIS

25 *Claims 1-5, 10-12, 14-16, and 18 rejected under 35 U.S.C. § 103(a) as*
26 *unpatentable over Hertz and Avis.*

1 *Claims 1-5, 10, 11, and 14-17*

2 The Appellants argue claims 1-5, 10, 11, and 14-17 as a group.

3 Accordingly, we select claim 1 as representative of the group.

4 37 C.F.R. § 41.37(c)(1)(vii) (2007).

5 The Examiner found that Hertz described all of the limitations of
6 claim 1 except for storing the agreement. The Examiner further found that
7 (1) it was known to those of ordinary skill that rental agreements as in Hertz
8 were stored for retrieval; (2) Avis described storing a rental agreement; and
9 (3) that one of ordinary skill would have known that Hertz and Avis were
10 describing similar products. The Examiner concluded it would have been
11 obvious to a person of ordinary skill in the art to have applied Avis' storage
12 of a rental agreement to Hertz because of the commonality of contents
13 between Hertz and Avis (Answer 4-5).

14 The Appellants contend that Neither Hertz nor Avis describe an
15 electronic rental agreement, and therefore do not describe or suggest
16 limitation [5] of claim 1 (Appeal Br. 5:Second ¶). The Appellants argue that
17 an agreement is a contract (Appeal Br. 5:First ¶), and there is no meeting of
18 minds in Hertz as to price and optional items, which the Appellants
19 characterize as essential terms of a rental contract. The Appellants cite
20 several court opinions for the proposition that failure to agree on essential
21 terms negates a contract. The Appellants also contend that Hertz fails to
22 describe element [1a] of claim 1.

23 We disagree. Initially, we find that the Appellants admit that Hertz
24 stores an electronic reservation agreement (FF 05). We next must construe
25 the term "electronic rental agreement" in limitation [5] of claim 1. This term

1 is not defined lexicographically by the disclosure (FF 03). The noun
2 “agreement” has several definitions.

3 While one of those definitions, within a legal context, is narrowly
4 drawn to a contract, as argued by the Appellants, a broader definition, still
5 within the ambit of the claimed subject matter, is an arrangement between
6 parties regarding a course of action, or even simply an accord (FF 04).
7 Since limitations are construed as broadly as reasonable during examination,
8 we construe an agreement to be an accord.

9 Thus an electronic rental agreement is an accord as to a rental entered
10 by electronic means. Thus, the electronic reservation for a vehicle rental
11 agreement described by Hertz, as admitted by the Appellants, is an accord as
12 to a rental entered by electronic means.

13 Even absent such an admission, we find that Hertz describes a screen
14 offering a vehicle rental for value, including all of the material terms, and
15 requesting acceptance (FF 10). The request for acceptance implies the
16 subsequent act of acceptance, which would create a contract. Whether such
17 a contract were contingent on certain performance, such as picking up the
18 vehicle, would not diminish the character of the agreement as a contract, and
19 certainly not as an agreement as to the terms contained therein. Finally,
20 even were a court to find that a specific instance of an agreement in Hertz
21 were not a contract, we find there would be no patentable distinction
22 between such an agreement by Hertz and a contract as such, because any
23 such distinction would be predicated entirely upon the nonfunctional
24 descriptive contents of the agreement. *See Ngai*, 367 F.3d at 1339.

1 portions of what their agreements contain within the pages of their web site
2 (FF 01). Therefore, we find that the customer profiles, combined with the
3 non-discretionary portions of Hertz's rental contract, together form a rental
4 agreement from which copies are made. We next find that after using the
5 data from a customer profile to create an agreement, that data may be
6 modified (FF 07). Such editing does not rely upon the customer profile, and
7 certainly does not result in altering the customer profile data.

8 We conclude that Hertz does describe modifying some information
9 from a master agreement without modifying the master agreement.

10 *Claim 12*

11 Claim 12 further requires storing a flag along with the unique
12 transaction in the database system to indicate that the accepted rental
13 proposal is electronically signed.

14 The Examiner found that Hertz accepts an indication of acceptance,
15 which is inherently stored by Hertz, and that such a data element indicating
16 acceptance is an example of a flag (Answer 6).

17 The Appellants contend that Hertz describes only reserving a vehicle
18 and therefore does not contain an electronic signature of acceptance (Appeal
19 Br. 11-12).

20 We disagree. Hertz explicitly requests a click to accept a reservation
21 (FF 10). Since such clicking to accept is electronically created evidence of
22 acceptance, it forms an electronic signing. One of ordinary skill knew that
23 the data element indicating whether such click had occurred was referred to
24 by the term of art, flag (FF 15).

Claim 18

Claim 18 further requires completing and storing the electronic rental agreement based upon the accepted rental proposal without completing a handwritten rental agreement.

The Examiner found that Hertz describes entering an agreement electronically rather than in hand writing (Answer 7-8).

The Appellants repeat their argument in support of the patentability of claim 1. We find this argument unpersuasive here for the same reasons we found as to claim 1, *supra*.

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 1-5, 10-12, 14-16, and 18 under 35 U.S.C. § 103(a) as unpatentable over Hertz and Avis.

Claims 6-9 rejected under 35 U.S.C. § 103(a) as unpatentable over Hertz, Avis, and Coutts.

The Appellants argue claims as a group.

Accordingly, we select claim 6 as representative of the group.

Claim 6 further requires maintaining a history of rental information for prior rentals by a user; entering information from an identification of a user; and entering at least some of rental-related information from the history based upon information from an identification of a user without employing a master rental agreement.

The Examiner found that Coutts describes entering information from transaction history and that one of ordinary skill would know the benefits of using historical transaction data to assist in completing a form. The

1 Examiner concluded it would have been obvious to a person of ordinary skill
2 in the art to have applied Coutts' data entry from history to the form
3 completion in Hertz to assist in completing Hertz's form (Answer 8).

4 The Appellants contend that Coutts is directed to banking machines
5 and therefore is non-analogous art (Appeal Br. 15-16).

6 We disagree. Coutts is directed to self service systems generally (FF
7 14). Kiosks such as those used for car rentals would be species of the genus
8 of self service systems to which Coutts applies. Coutts describes the
9 advantages of using transaction history in filling forms with such kiosks (FF
10 13).

11 When a work is available in one field of endeavor, design
12 incentives and other market forces can prompt variations of it,
13 either in the same field or a different one. If a person of
14 ordinary skill can implement a predictable variation, § 103
15 likely bars its patentability. For the same reason, if a technique
16 has been used to improve one device, and a person of ordinary
17 skill in the art would recognize that it would improve similar
18 devices in the same way, using the technique is obvious unless
19 its actual application is beyond his or her skill.

20 *KSR*, 127 S.Ct. at 1740.

21 The Appellants have not sustained their burden of showing that the
22 Examiner erred in rejecting claims 6-9 under 35 U.S.C. § 103(a) as
23 unpatentable over Hertz, Avis, and Coutts.

24 *Claims 13 and 17 rejected under 35 U.S.C. § 103(a) as unpatentable over*
25 *Herz, Avis, and Kiosk.com.*

26 The Appellants relied on their arguments in support of claims 1 and
27 12, which we found did not overcome the Appellants' burden of showing

1 error, and therefore the Appellants have not sustained their burden of
2 showing that the Examiner erred in rejecting claims 13 and 17 under 35
3 U.S.C. § 103(a) as unpatentable over Herz, Avis, and Kioskcom.

4 CONCLUSIONS OF LAW

5 The Appellants have not sustained their burden of showing that the
6 Examiner erred in rejecting claims 1-18 under 35 U.S.C. § 103(a) as
7 unpatentable over the prior art.

8 On this record, the Appellants are not entitled to a patent containing
9 claims 1-18.

10 DECISION

11 To summarize, our decision is as follows:

- 12 • The rejection of claims 1-5, 10-12, 14-16, and 18 under 35 U.S.C. §
13 103(a) as unpatentable over Hertz and Avis is sustained.
- 14 • The rejection of claims 6-9 under 35 U.S.C. § 103(a) as unpatentable
15 over Hertz, Avis, and Coutts is sustained.
- 16 • The rejection of claims 13 and 17 under 35 U.S.C. § 103(a) as
17 unpatentable over Herz, Avis, and Kioskcom is sustained.

18 No time period for taking any subsequent action in connection with
19 this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

20 AFFIRMED

Appeal 2007-3067
Application 09/698,502

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